

REMARKS

Reconsideration is respectfully requested.

Claims 1-40 are pending. Claims 41-78 have been canceled.

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Claims 1 and 36-40 have been amended to insert the term "transparent" in the description of the overcoat material. Basis for this amendment is found in the specification on pages 7, 8, 9 and 10 where either of the terms "transparent" or its synonym "clear" are used to describe the protective overcoat. Claim 1 and 8 have also been amended to incorporate subject matter of canceled claims 2 and 8. No new matter has been added.

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Claim 1 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 101 of copending Application No. 10/439,797; claims 114 and 124 of copending Application 10/439,798; and claims 94 and 104 of copending Application No. 10/439,993. A terminal disclaimer signed by the assignee's attorney and fully complying with 37 CFR 3.73(b) is attached herewith. With the filing of this terminal disclaimer, the applicants assert that the obviousness-type double patenting provisional rejections are overcome. The applicants request that the rejections therefore be withdrawn.

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Claims 1-6, 12-15, 17-20, 22-24, 29-30, 32,34, 36 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,397 to Gordon. Furthermore, claims 8-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,397 to Gordon et al. in view of U.S. Patent No. 4,861,409 to Hashida et al. In addition claims 7 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,397 to Gordon et al. in view of U.S. Patent No. 4,724,026 to Nelson. Also claims 21, 26, 27 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,397 in view of U.S. Patent No. 5,203,941 to Spain et al. Finally claims 31 and 38-40 stand rejected un-

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der 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,486,397 to Gordon et al. in further view of U.S. Patent No. 5,932,352 to Higgins.

In a claimed embodiment, the presently-claimed invention is a method of applying a transparent, protective overcoat to a surface of a printed transparency, the method comprising:

5 applying heat and pressure to a donor web having a carrier side comprising carrier ribbon material and a transfer side comprising transparent, protective overcoat material, wherein the heat and pressure facilitate release of a section of the transfer side from adhering to the carrier side of the donor web and

10 facilitate transfer of the section of the transfer side to adhering to the surface of the transparency.

15 All the pending claims, claims 1-40, relate to a thermal transfer overcoat system having a donor web with a transfer side comprising an uncut transparent protective overcoat material. When the uncut transparent protective overcoat material is applied by heat and pressure uniformly to a surface of a printed transparency, a section of the overcoat material is released to adhere to the

20 surface of the printed transparency without the need to precut or cut the transparent overcoat material, and wherein at least a portion of an exterior surface of the base comprises a surface material resistant to the transparent overcoat material adhering to the exterior surface so that only the transparent overcoat section adhering to the printed transparency is separated from the donor web.

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In contrast, Gordon teaches the use of a reflective protective overcoat on a transparent imaged substrate. In Gordon, the image is not viewed through the overcoat; rather it is viewed through the substrate. Gordon stands therefore in contrast to the presently claimed invention in which the image is

30 viewed through the transparent overcoat. Furthermore, Gordon employs only a roller as the pressing and stabilizing device under the medium when it is coated with the protective coat (Gordon, column 16, lines 3-18). Most impor-

tantly, Gordon's reflective protective overcoat is not transparent but reflective because of particulate solid such as magnesium silicate which is dispersed throughout the overcoat. These particles dispersed throughout the overcoat not only serve to impart the overcoat's reflective quality, they also serve to assist accurate breakage of the overcoat (Gordon, column 8, lines 46-54; also column 9, lines 8-11).

In summary, Gordon teaches that when the reflective overcoat is applied by heat and pressure to the imaged substrate, the obtaining of accurate cutting of the overcoat is ensured by a dispersion of solid particles in the overcoat. Gordon does not suggest how a transparent overcoat without such particles could achieve cutting and separation. Nor does Gordon suggest that a base with a releasable surface would further enhance the cutting/separation process when heat and pressure is applied to an overcoat.

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The second reference, Hashida, teaches bonding together a first film to a second film using a nipping roll unit with a heat roll and a pressure roll. The rolls are coated with a non-tacky substance which prevents the films from sticking to the rolls and thus enhances the accuracy of the lamination of the two rolls. Hashida does not however teach or suggest a base coated with a releasable surface which makes possible the accurate cutting and separation of one of the films as it is laminated to the other film. In Hashida, the releasable surface is used only for the simple purpose of preventing the laminate sticking to the roller with no cutting involved. If the releasable surface from Hashida were used in the system of Gordon, it would only serve the same purpose it serves in Hashida, preventing the laminate from sticking to the roller, the dispersed particles in the reflective overcoat of Gordon already serving the purpose of making the overcoat more accurately breakable without the need of a releasable surface.

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A combination of Gordon with either Nelson, Cahill, Spain or Higgins would not achieve or suggest the presently claimed invention. Cahill, Spain and

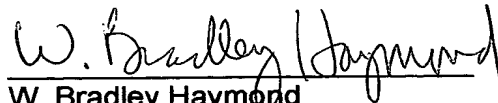
Higgins all teach one particular aspect of a specific embodiment of the invention but are not necessary to achieve a general embodiment of the presently claimed invention. Nelson teaches a lamination system which uses a base to give support to a receiving substrate which is being laminated to a foil transfer sheet with the application of heat and pressure. Nelson does not however teach or suggest that the base is covered with a releasable surface to enhance the separation of the metal foil from the transfer sheet. Thus Nelson teaches nothing about the base being used to enhance the cutting/separation process of the overcoat sheet and thus provides nothing that could be combined with Gordon that would lead to the presently claimed invention.

The combination of all of the references together or any combinations thereof do not teach the presently claimed invention. As discussed above, There would therefore be no motivation for one skilled in the art to combine the references and achieve something suggesting the presently claimed invention. Furthermore, if any such combination were made, nothing like the presently invention would be achieved.

In view of the terminal disclaimer and the above amendments and arguments,
the applicants respectfully request that the above rejections be withdrawn.

Respectfully submitted,

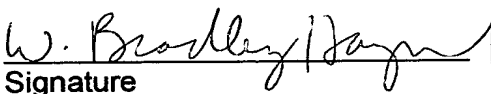
Kasperchik et al.



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25 Date of Signature